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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,960	10/06/2004	Danny S Moshe	28559	7541

7590 10/19/2007  
Martin Moynihan  
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EXAMINER

TURNER, SAMUEL A

ART UNIT	PAPER NUMBER
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2877

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10/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

417

<b>Office Action Summary</b>	Application No. 10/508,960	Applicant(s) MOSHE, DANNY S	
	Examiner Samuel A. Turner	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 30 July 2007 have been fully considered but they are not persuasive.

Applicant's amendment has overcome the rejection of claims 3-11 under 35 U.S.C. § 112, first paragraph.

Applicant's amendment has overcome the rejection of claims 23-27, and 29-37 under 35 U.S.C. § 101.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant's arguments with respect to claims 3-8, 11, 21, 22, 38-43, 46, 56-60, 63, 73, 86, 87, and 90 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517) in view of Tsuda(6,697,160) have been considered and are not persuasive, see pages 39-41 of Applicant's remarks. The rejection of claims 3-8, 11, 21, 22, 38-43, 46, 56-60, 63, 73, 86, 87, and 90 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

Applicant's arguments with respect to claims 9, 10, 12, 13, 23, 24, 27-37, 44, 45, 47, 48, 61, 62, 64, 65, 88, 89, 91, and 92 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517) and Tsuda(6,697,160) in view of Erickson(5,440,388) have been considered and are not persuasive, see page 41 of Applicant's remarks. The rejection of claims 9, 10, 12, 13, 23, 24, 27-37, 44, 45, 47, 48, 61, 62, 64, 65, 88, 89, 91, and 92 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

Applicant's arguments with respect to claims 14-17, 49-52, 66-69, and 93-96 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517) and Tsuda(6,697,160) in view of Schwiesow(4,444,501) have been considered and are not persuasive, see page 41 of Applicant's remarks. The rejection of claims 14-17, 49-52, 66-69, and 93-96 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

Applicant's arguments with respect to claims 18-20, 53-55, 70-72, and 97-99 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517), Tsuda(6,697,160), and Schwiesow(4,444,501) Seago et al(5,801,830) have been considered and are not persuasive, see page 41 of Applicant's remarks. The rejection of claims 18-20, 53-55, 70-72, and 97-99 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

Applicant's arguments with respect to claim 25 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517), Tsuda(6,697,160), and Erickson(5,440,388) in view of Inoue et al(5,253,183) have been considered and are not persuasive, see page 41 of Applicant's remarks. The rejection of claim 25 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

Applicant's arguments with respect to claim 26 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517), Tsuda(6,697,160), and Erickson(5,440,388) in view of Cabib et al(6,088,099) have been considered and are not persuasive, see page 41 of Applicant's remarks. The rejection of claim 26 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

Applicant's arguments with respect to claims 74, 76-85, 100, and 102-111 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517) and Tsuda(6,697,160) Bleier et al(5,949,543) have been considered and are not persuasive, see page 41 of Applicant's remarks. The rejection of claims 74, 76-85, 100, and 102-111 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

Applicant's arguments with respect to claims 75 and 101 rejected under 35 U.S.C. § 103(a) as being unpatentable over Cabib et al(5,539,517), Tsuda(6,697,160), and Bleier et al(5,949,543) in view of Carangelo et al(5,486,917) have been

considered and are not persuasive, see page 41 of Applicant's remarks. The rejection of claims 75 and 101 under 35 U.S.C. § 103(a) in the office action dated 29 January 2007 is repeated and made final.

### **CLAIMS 3, 38, 56, and 86:**

Applicant begins by reviewing the invention of Cabib et al(5,539,517), see pages 34-36. However, Applicant only addresses the embodiment of figure 13 which is applied to the rejection of claims 3, 38, 56, and 86 on page 36 where column 15, lines 34-44 are partially repeated. Applicant then reviews the invention of Tsuda(6,697,160), see pages 36-39.

Applicant presents four arguments as to why the rejection of independent claims 3, 38, 56, and 86 is not obvious with respect to Cabib et al(5,539,517) in view of Tsuda(6,697,160).

First, Applicant states that the type of optical path length variation corrections which are made by operating any of the various embodiments taught by Tsuda, would not have provided motivation for one of ordinary skill in the art at the time the invention was made to modify Cabib et al. This statement is a conclusion which fails to specifically point out how the language of the claims patentably distinguishes them from the references and thus does not comply with the requirements of section 37 CFR § 1.111 (b). The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce

the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art.

Second, Applicant argues that the proposed modification with regard to the addition of a path length sensor would require a non-obvious redesign or change in operating principle. Applicant bases this argument on adding a phase element found in Tsuda to the combination, which is an attempt to bodily incorporate the teachings of Tsuda instead of what Tsuda suggest to the skilled artisan.

Third, Applicant argues that a modification of Cabib et al with Tsuda would render the spectrometer unsatisfactory for its intended purpose, and would not lead to the invention as claimed. This statement is a conclusion which fails to specifically point out how the language of the claims patentably distinguishes them from the references and thus does not comply with the requirements of section 37 CFR § 1.111 (b).

Fourth, Applicant argues that would not reasonably be expected to succeed in arriving at the present invention claimed by independent claims 3, 38, 56, and 86. This statement is a conclusion which fails to specifically point out how the language of the claims patentably distinguishes them from the references and thus does not comply with the requirements of section 37 CFR § 1.111 (b).

Applicant has failed to point out why the combination of Cabib et al and Tsuda would fail to function or why there would be no reasonable expectation of

success. Alternatively, Applicant has failed to point out any language in the claims which would distinguish them from the combination of Cabib et al and Tsuda.

### **CLAIMS 4-37, 39-55, 57-85, and 87-111:**

Applicant argues that claims 4-37, 39-55, 57-85, and 87-111 are dependent from either claims 3, 38, 56, or 86 and are allowable for the reasons given in regard to the arguments with respect to claims 3, 38, 56, or 86. Therefore, claims 4-37, 39-55, 57-85, and 87-111 stand or fall with independent claims 3, 38, 56, and 86.

#### ***Action Made Final***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A. Turner whose phone number is 571-272-2432.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr., can be reached on 571-272-2800 ext. 77.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel A. Turner  
Primary Examiner  
Art Unit 2877